



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

STERNE KESSLER GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE NW
WASHINGTON DC 20005

MAILED
NOV 22 2010
OFFICE OF PETITIONS

In re Application :
Zauderer, et al. : DECISION ON APPLICATION FOR
Application No. 09/987,456 : PATENT TERM ADJUSTMENT
Filed: November 14, 2001 :
Attorney Docket No. :
1821.0070004/EJH/T-M :

This letter is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION UNDER 37 C.F.R. § 1.705(b)", filed July 6, 2010. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one thousand one hundred thirty-three (1133) days to one thousand one hundred eighty-six (1186) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

On April 6, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is one thousand one hundred thirty-three (1133) days. On July 6, 2010, Applicant timely¹ submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is one thousand one hundred eighty-six (1186) days.

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

¹ Applicants filed the application for patent term adjustment on the same date as the issue fee.

The Office initially determined a patent term adjustment of one thousand one hundred thirty-three (1133) days based on an adjustment for PTO delay of two hundred thirty-nine (239) days pursuant to 37 CFR 1.703(a)(1), fourteen (14) days pursuant to 37 CFR 1.703(a)(2), and one thousand one hundred fifty-four (1154) days pursuant to 37 CFR 1.703(b)(4), reduced by Applicant's delays of one hundred twenty-six (126) days pursuant to 37 CFR 1.704(b), and sixty-one (61), four (4), and eighty-three (83) days pursuant to 37 CFR 1.704(c)(8). The 126 days of Applicant delay are at issue.

Applicant argues that they should not have been assessed 126 days of delay, but rather only 66 days. The Office mailed a Restriction Requirement on September 10, 2003. Applicants filed a reply on October 10, 2003. However, Applicants state that the reply was misplaced, so Applicants re-filed the reply on December 11, 2003.² The Office mailed a Notice of Non-Compliant Amendment on February 11, 2004, to which Applicants filed a proper reply on February 13, 2004, and were assessed 126 days of delay pursuant to 37 CFR 1.704(c)(7). Applicants argue that the period of delay should not begin on October 11, 2003, but rather on December 12, 2003. Applicants state that to do otherwise would penalize them for filing their reply timely on October 10, 2003. In addition, Applicants argue that the Office should have incurred 63 days of delay for not "docketing" their response until December 11, 2003. Applicants' argument has been considered, but is not persuasive. Applicants were not penalized for filing their reply on October 10, 2003, but the issue was that Applicants' reply was not proper. Had Applicants filed a proper reply, they would not have incurred any delay under 37 CFR 1.704(c)(7). Moreover, there are no provisions in the rule for the Office to timely mail a Notice of Non-Compliant Amendment in instances where an applicant files a non-compliant reply.

In addition, Applicants point out that they should have been assessed additional delay of 70 days for filing a Amended Appeal Brief. Applicants filed an Appeal Brief on April 27, 2007. The Office mailed a Notice of Non-Compliant Appeal Brief on June 6, 2007, to which Applicants responded by filing a compliant Appeal Brief on July 6, 2007. Accordingly, pursuant to 37 CFR 1.704(c)(7), 70 days of Applicant delay should have been assessed.

² The reply appears in the application file with a filing date of October 10, 2003.

Applicants also argue that additional Office delay should have been assessed due to the failure of the Office to issue the patent within three years. However, this argument is prematurely raised. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term applicants are entitled to for Office failure to issue the patent within 3 years. This is true even where a Request for Continued Examination (RCE) was filed (the computer will not undertake the 1.702(b) calculation until the actual date of issuance of the patent has been determined). Applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d).

Lastly, a review of the file reveals that Applicants should have been assessed additional delay for filing a supplemental IDS on October 13, 2005. Applicants had previously filed an RCE on July 21, 2005. Accordingly, pursuant to 37 CFR 1.704(c)(8), applicant delay of eighty-four (84) days should have been assessed for this filing.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **nine hundred seventy-nine (979) days** (1407 days of PTO delay (1154+14+239) reduced by 428 (70+83+4+84+61+126) days of applicant delay).

Receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged.

The application is being forwarded to the Office of Data Management for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.



Anthony Knight
Director
Office of Petitions



Patent Term Adjustments



PTA/PTE Information Patent Term Adjustment Patent Term Extension

Application Number*: 09987456

Search

Explanation of PTA Calculation

Explanation of PTE Calculation

PTA Calculations for Application: 09987456

Application Filing Date: 11/14/2001	Overlapping Days Between (A and B) or (A and C): 0
Issue Date of Patent:	Non-Overlapping USPTO Delays: 1407
A Delays: 253	PTO Manual Adjustment: 154
B Delays: 0	Applicant Delay (APPL): 274
C Delays: 1154	Total PTA (days): 979

* - Sorted Column

File Contents History

Action Number	Action Recorded Date	Action Due Date	Action Code	Action Description	Duration PTO	Duration APPL	Parent Action Number
183	11/22/2010		P028	Adjustment of PTA Calculation by PTO	79	0	
182	11/22/2010		P028	Adjustment of PTA Calculation by PTO	84	0	
172	04/06/2010		MA/-	Mail Notice of Allowance		0	
171	04/05/2010		IREV	Issue Revision Completed		0	
170	04/05/2010		DVER	Document Verification		0	
169	04/05/2010		N/-	Notice of Allowance Data Verification Completed		0	
168	04/05/2010		INH	Not Inherited		0	
167	04/05/2010		DOCK	Case Docketed to Examiner in GAU		0	
166	04/02/2010		HM327-E	Mail BOA miscellaneous communication to applicant		0	
165	04/01/2010		M327-E	BOA miscellaneous communication to applicant		0	
164	03/31/2010		CNTA	Notice of Allowability	1154	0	
158	03/29/2010	01/31/2007	MAPDR	Mail BPAI Decision on Appeal - Reversed		91	
157	03/29/2010		APDR	BPAI Decision - Examiner Reversed		0	
156	02/17/2010		INH	case Inherited		0	
155	02/04/2010		APCH	Confirmation of Hearing by Appellant		0	
154	01/14/2010		APNH	Notification of Appeal Hearing		0	
148	05/05/2009		AP_DK_M	Docketing Notice Mailed to Appellant		0	
147	05/04/2009		APAS	Assignment of Appeal Number		0	
146	03/10/2009		HM327	Mail Miscellaneous Communication to Applicant		0	
145	03/10/2009		M327	Miscellaneous Communication to Applicant - No Action Count		0	
144	03/09/2009		APWD	Appeal Awaiting BPAI Docketing		0	
141	03/06/2009		HM327	Mail Miscellaneous Communication to Applicant		0	
140	03/04/2009		M327	Miscellaneous Communication to Applicant - No Action Count		0	
138	03/04/2009		APRD	Order Returning Undocketed Appeal to the Examiner		0	
137	08/12/2008		APWD	Appeal Awaiting BPAI Docketing		0	
136	08/07/2008		DOCK	Case Docketed to Examiner in GAU		0	
139	05/21/2008		IDSC	Information Disclosure Statement considered		0	
135	05/21/2008		M844	Information Disclosure Statement (IDS) Filed		0	
134	05/21/2008		WIDS	Information Disclosure Statement (IDS) Filed		0	
133	12/27/2007		HM327	Mail Miscellaneous Communication to Applicant		0	
132	12/21/2007		M327	Miscellaneous Communication to Applicant - No Action Count		0	
124	12/03/2007		IDSC	Information Disclosure Statement considered		0	
123	12/03/2007		M844	Information Disclosure Statement (IDS) Filed		0	
122	12/03/2007		WIDS	Information Disclosure Statement (IDS) Filed		0	
142	11/16/2007		IDSC	Information Disclosure Statement considered		0	
120	11/16/2007		M844	Information Disclosure Statement (IDS) Filed		0	
119	11/16/2007		WIDS	Information Disclosure Statement (IDS) Filed		0	
118	10/23/2007		FWDX	Date Forwarded to Examiner		0	
131	10/16/2007		MRBNE	Mail Reply Brief Noted by Examiner		0	
115	10/16/2007		MRBNE	Mail Reply Brief Noted by Examiner		0	
114	10/16/2007		MAPE2	Mail Supplemental Examiner's Answer		0	
130	10/15/2007		RBNE	Reply Brief Noted by Examiner		0	
113	10/15/2007		AFE2	2nd or Subsequent Examiner's Answer to Appeal Brief		0	
112	10/15/2007		RBNE	Reply Brief Noted by Examiner		0	
117	10/10/2007		APRB	Reply Brief Filed		0	
116	10/10/2007		APOH	Request for Oral Hearing		0	
111	09/05/2007		YCRD	Return of Undocketed appeal to the TC		0	
110	09/05/2007		PACC	Exam. Ans. Review Complete		0	
143	08/08/2007		IDSC	Information Disclosure Statement considered		0	
109	08/08/2007		M844	Information Disclosure Statement (IDS) Filed		0	
107	08/08/2007		WIDS	Information Disclosure Statement (IDS) Filed		0	
106	08/06/2007		APEA	Examiner's Answer to Appeal Brief		0	
105	08/02/2007		APBR	Appeal Brief Review Complete		0	
104	08/02/2007		FWDX	Date Forwarded to Examiner		0	
103	07/06/2007		AP.B	Appeal Brief Filed		0	
102	06/06/2007		APBD	Notice -- Defective Appeal Brief		0	
99	06/04/2007		APBR	Appeal Brief Review Complete		0	
101	04/27/2007		AF/D	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		0	
100	04/27/2007		AABR	Amendment After Brief		0	
97.1	04/27/2007		APBI	Defective / Incomplete Appeal Brief Filed		0	
97	04/27/2007		AP.B	Appeal Brief Filed		0	
96	04/27/2007		XT/G	Request for Extension of Time - Granted		0	
94	02/28/2007		MAPCP	Mail Appeals conf. Proceed to BPAI		0	
93	02/26/2007		APCP	Pre-Appeals Conference Decision - Proceed to BPAI		0	
92	01/31/2007		AP.C	Request for Pre-Appeal Conference Filed		0	
91	01/31/2007		N/AP	Notice of Appeal Filed		0	
90	10/31/2006		MCTFR	Mail Final Rejection (PTOL - 326)		0	
95	10/16/2006		IDSC	Information Disclosure Statement considered		0	
89	10/16/2006		RCAP	Reference capture on IDS		0	
88.7	10/16/2006	07/25/2006	M844	Information Disclosure Statement (IDS) Filed		82	82
88	10/16/2006		WIDS	Information Disclosure Statement (IDS) Filed		0	
87	10/16/2006		CTFR	Final Rejection		0	
85	08/04/2006		TSSCOMP	IFW TSS Processing by Tech Center Complete		0	
83	08/04/2006		FWDX	Date Forwarded to Examiner		0	
86	07/25/2006		IDSC	Information Disclosure Statement considered		0	
84.7	07/25/2006		M844	Information Disclosure Statement (IDS) Filed		0	
84	07/25/2006		WIDS	Information Disclosure Statement (IDS) Filed		0	
82	07/25/2006	07/21/2006	A...	Response after Non-Final Action		4	69
81	07/25/2006		XT/G	Request for Extension of Time - Granted		0	
80	07/25/2006		RCAP	Reference capture on IDS		0	
69	04/21/2006		MCTNF	Mail Non-Final Rejection		0	
68	04/17/2006		CTNF	Non-Final Rejection		0	
63	02/09/2006		FWDX	Date Forwarded to Examiner		0	
61	02/09/2006		FWDX	Date Forwarded to Examiner		0	
59	02/09/2006		ABN9	Disposal for a RCE / CPA / R129		0	
67	02/02/2006		IDSC	Information Disclosure Statement considered		0	
65	02/02/2006		RCAP	Reference capture on IDS		0	
64.7	02/02/2006		M844	Information Disclosure Statement (IDS) Filed		0	

64	02/02/2006		WIDS	Information Disclosure Statement (IDS) Filed		0
62	02/02/2006		AMSB	Amendment Submitted/Entered with Filing of CPA/RCE		0
60	02/02/2006		RCEX	Request for Continued Examination (RCE)		0
58	02/02/2006		BRCE	Workflow - Request for RCE - Begin		0
57	02/02/2006		FRCE	Workflow - Request for RCE - Finish		0
56	02/02/2006		BRCE	Workflow - Request for RCE - Begin		0
55	12/02/2005		LET	Miscellaneous Incoming Letter		0
54	11/02/2005		MCTFR	Mail Final Rejection (PTOL - 326)		0
53	10/31/2005		CTFR	Final Rejection		0
66	10/13/2005		IDSC	Information Disclosure Statement considered		0
52	10/13/2005		RCAP	Reference capture on IDS		0
51.7	10/13/2005		MB44	Information Disclosure Statement (IDS) Filed		0
51	10/13/2005		WIDS	Information Disclosure Statement (IDS) Filed		0
49	07/27/2005		FWDX	Date Forwarded to Examiner		0
47	07/27/2005		FWDX	Date Forwarded to Examiner		0
45	07/27/2005		ABN9	Disposal for a RCE / CPA / R129		0
77	07/27/2005		AF/D	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		0
76	07/27/2005		AF/D	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		0
75	07/27/2005		AF/D	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		0
74	07/27/2005		AF/D	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		0
73	07/27/2005		AF/D	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		0
72	07/27/2005		AF/D	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		0
71	07/27/2005		AF/D	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		0
70	07/27/2005		AF/D	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		0
50	07/27/2005		AF/D	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		0
48	07/27/2005		AMSB	Amendment Submitted/Entered with Filing of CPA/RCE		0
46	07/27/2005		RCEX	Request for Continued Examination (RCE)		0
44	07/27/2005		BRCE	Workflow - Request for RCE - Begin		0
43	04/21/2005	04/07/2005	MCTFR	Mail Final Rejection (PTOL - 326)	14	40
42	04/18/2005		CTFR	Final Rejection		0
41	12/22/2004		FWDX	Date Forwarded to Examiner		0
40	12/07/2004		A...	Response after Non-Final Action		0
39	12/07/2004		RCAP	Reference capture on IDS		0
38.7	12/07/2004		MB44	Information Disclosure Statement (IDS) Filed		0
38	12/07/2004		WIDS	Information Disclosure Statement (IDS) Filed		0
37	12/07/2004		WAMD	Workflow incoming amendment IFW		0
36	09/07/2004		MCTNF	Mail Non-Final Rejection		0
35	09/03/2004		CTNF	Non-Final Rejection		0
34.7	07/28/2004	05/28/2004	MB44	Information Disclosure Statement (IDS) Filed	61	32
34	07/28/2004		WIDS	Information Disclosure Statement (IDS) Filed		0
33	06/15/2004		FWDX	Date Forwarded to Examiner		0
32	05/28/2004		ELC	Response to Election / Restriction Filed		0
31	05/28/2004		WAMD	Workflow incoming amendment IFW		0
30	04/28/2004		MCTRS	Mail Restriction Requirement		0
29	04/27/2004		CTRS	Requirement for Restriction / Election		0
28	02/25/2004		FWDX	Date Forwarded to Examiner		0
27	02/13/2004	10/10/2003	ELC	Response to Election / Restriction Filed	128	21
26	02/11/2004		NINA	Mail Notice of Informal or Non-Responsive Amendment		0
25	02/11/2004		FWDX	Date Forwarded to Examiner		0
23	12/19/2003		TSSA	IFW Amended case processing Complete		0
22	12/19/2003		FWDX	Date Forwarded to Examiner		0
24	12/11/2003		SA...	Supplemental Response		0
21.1	10/10/2003		A.L.	Informal or Non-Responsive Amendment after Examiner Action		0
21	10/10/2003		ELC	Response to Election / Restriction Filed		0
20	09/10/2003	01/14/2003	MCTRS	Mail Restriction Requirement	232	21
19	09/08/2003		CTRS	Requirement for Restriction / Election		0
79	05/01/2003		RCAP	Reference capture on IDS		0
18.7	05/01/2003		MB44	Information Disclosure Statement (IDS) Filed		0
18	05/01/2003		WIDS	Information Disclosure Statement (IDS) Filed		0
16.7	11/06/2002		MB44	Information Disclosure Statement (IDS) Filed		0
16	11/06/2002		WIDS	Information Disclosure Statement (IDS) Filed		0
15	10/04/2002		DOCK	Case Docketed to Examiner in GAU		0
14	07/12/2002		DOCK	Case Docketed to Examiner in GAU		0
13	06/12/2002		A-PE	Preliminary Amendment		0
12	06/05/2002		DOCK	Case Docketed to Examiner in GAU		0
78	05/28/2002		RCAP	Reference capture on IDS		0
17.7	05/28/2002		MB44	Information Disclosure Statement (IDS) Filed		0
17	05/28/2002		WIDS	Information Disclosure Statement (IDS) Filed		0
11	04/27/2002		DOCK	Case Docketed to Examiner in GAU		0
10	03/22/2002		OIPE	Application Dispatched from OIPE		0
9	03/22/2002		CONP	Application Is Now Complete		0
7	02/21/2002		FLFEE	Payment of additional filing fee/Preexam		0
6	02/21/2002		OATHDECL	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant		0
5	01/23/2002		CRFE	CRF Is Good Technically / Entered into Database		0
4	12/21/2001		INCD	Notice Hailed - Application Incomplete - Filing Date Assigned		0
3	11/19/2001		SCAN	IFW Scan & PACR Auto Security Review		0
2	11/19/2001		SCAN	IFW Scan & PACR Auto Security Review		0
1	11/14/2001		IEXX	Initial Exam Team nn		0

Export to: Excel

on Explorer

on Explorer

on Explorer

on Explorer

on Explorer

on Explorer

on Explorer

on Explorer

on Explorer

on Explorer

on Explorer

on Explorer

on Explorer

on Explorer

on Explorer

on Explorer